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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,644	07/03/2003	Garrett Henley Barnes	0015-0001	4623

35483 7590 03/26/2007
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EXAMINER

PATEL, TARLA R

ART UNIT	PAPER NUMBER
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3772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/613,644

Applicant(s)

BARNES ET AL.

Examiner

Tarla R. Patel

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the a top side and a bottom side as mentioned in claim 12 and a cushion material between said top surface and said bottom surface as mentioned in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of

the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 12

the recitation of "a top side" and "a bottom side" is not described in specification.

4. The disclosure is objected to because of the following informalities: the Specification recites the phrase "peel and stick" throughout. It is unclear as to what the phrase "peel and stick" is defining structurally. The phrase "peel and stick" should be removed or further clarified to define structure. Appropriate correction is required and no new matter should be entered.

Claim Objections

5. Claims 1,2,13,23 and 24 are objected to because of the following informalities: Claims 2,13,23 and 24 recite the limitation or phrase "peel and stick". It is unclear as to what the phrase "peel and stick" is defining structurally. The phrase "peel and stick" should be removed or clarified in the claim to define structure. Appropriate correction is required.

6. Claim 1 recites the limitation, wherein "length about the length between of the associated backboard" which seems to have a grammatical error. It should be "length about the length of the associated backboard". Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1,6,12,17,23,28 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not support or define the cushion material between the top and bottom surfaces of the pad. On the contrary, Applicant discloses that the Pad is made of a polyurethane or polyvinylchloride or foam. Therefore, it is unclear what the further cushion material is and how it is between the surfaces.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 12 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of “a length about the length”, “a width about the width” is indefinite, since a length of a “length of the length” and a width of a “width of the width” of backboard is indefinite. Also, because there is no “length” and “width” of associated backboard ever defined. Therefore, the meets and bounds of the claim cannot be determined.

11. Claims 3, 15 and 26 contain the trademark/trade name VELCRO™.

Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a property or material and, accordingly, the identification/description is indefinite. It is unclear to what applicant is referring when claiming a material to be “VELCRO™”. The term “VELCRO™” is a trademark and is not intended to be used as an

adjective. Since it is not proper to claim materials by trademark, the term "VELCRO™" has been given no patentable weight.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

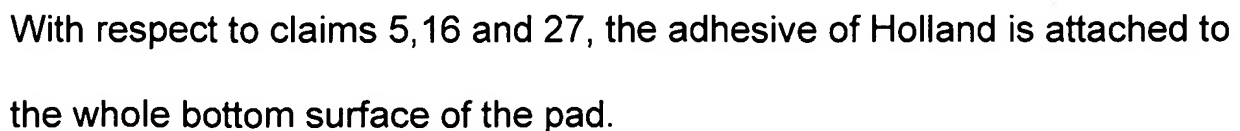
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1,2,4,5,8,10,13,14,16,19,21,24,25,27,30,32, and 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Holland (7,028,357).

Holland discloses a disposable pad apparatus system (see figure below) for use with an associated backboard, the pad comprises at least three sides, further comprising a right side having a length about the length of the associated backboard, a left side having a length about the length of the associated backboard, a top side having a width about the width of the associated backboard, a bottom side having width about the width of the

associated backboard (please see fig 1 for having length and width of associated backboard and bottom figure for all the elements). The pad also has a top surface, a bottom surface has an adhesive mechanism (52) attached thereto, the adhesive mechanism is used to releasably attached the pad apparatus system to the associated backboard. Holland further discloses a cushion material, examiner has interpreted to be the pad of Holland, since the cushion material is between the top surface and the bottom surface.



With respect to claims 8, 10, 19, 21, 30, and 32, Holland discloses a top surface with indicia, such as a line (60) to form a pad indexing mark that facilitates visual alignment of the pad with the upper surface of the backboard and to align the pad, which is interpreted as having print on the top surface as required by the claims.

With respect to claims 10, 21 and 32, it is the position of the examiner that it is inherent that pad is pre-sized, since the pad having indicia it is pre-sized to fit the associated backboard.

With respect to claims 34 and 35, Holland inherently discloses the method of using the pad apparatus system by exposing the adhesive mechanism, setting the pad upon the associated backboard by placing the bottom surface on the associated backboard and disposing the pad, since Holland discloses all structure limitations of pad.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3, 15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (357) in view of Hindes (4,168,554).

Holland substantially disclose the invention, please see rejection to claims 1,2,4,5,8,10,13,14,16,19,21,24,25,27,30,32, and 34-35; however Holland does not disclose that the pad has VELCRO™ as adhesive mechanism.

However Hindes teaches a cardiopulmonary resuscitation cot mattress with cushion attached to stiffening panel by VELCRO™ mechanism (19). At the time the invention was made, it would have been obvious to one having ordinary skill in the art to use the VELCRO™ mechanism as adhesive to pad of Holland as taught by Hindes to provide rapid access to remove the pad from backboard.

16. Claims 6,7,17,18,28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (357) in view of Walton (5,819,746).

With respect to claims 6,17, and 28 Holland substantially disclose the invention, please see rejection to claims

1,2,4,5,8,10,13,14,16,19,21,24,25,27,30,32, and 34-35; however, Holland does not disclose that the cushion is made of polyurethane material.

However, Walton teaches a removable spinal board padding made of polyurethane or polyvinyl chloride foam core (abstract). At the time the

invention was made, it would have been obvious to one having ordinary skill in the art to make the pad of Holland with polyurethane or polyvinyl chloride foam core material as taught by Walton to give waterproof and washable capacity to pad.

With respect to claims 7, 18 and 29 Holland and Walton substantially disclose the invention as claimed, however Holland/Walton do not specifically disclose that the pad is wrapped with a plastic cover. At the time of invention was made, it would have been obvious to wrap the pad with plastic, since medical equipment is routinely wrapped in plastic prior to use to keep it sterile.

17. Claims 9, 20 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (357) in view of Nixon et al (5,473,784).

Holland substantially disclose the invention, please see rejection to claims 1, 2, 4, 5, 8, 10, 13, 14, 16, 19, 21, 24, 25, 27, 30, 32, and 34-35; however Holland does not disclose that the bottom surface has a print.

However, Nixon teaches body board having indicia (66) or print in bottom surface of the board (column 11 lines 19-23). At the time the invention was made, it would have been obvious to one having ordinary skill in the art to

have the indicia in bottom as taught by Nixon to the pad of Holland to better align the pad to its associated backboard.

18. Claims 11,22 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (357) in view of Walton (5,819,746).

Holland substantially disclose the invention, please see rejection to claims 1,2,4,5,8,10,13,14,16,19,21,24,25,27,30,32, and 34-35; however Holland does not discloses that the pad is uncut. At the time the invention was made it would have been obvious matter of design choice to have pad is uncut, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

19. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (357).

Holland substantially disclose the invention, please see rejection to claims 1-2,4-5,8-10,12-14,16,19-21,23-25,27,30-32, and 34-35; however Holland does not discloses the method of doing business comprising selling a padding apparatus system in conjunction with an associated backboard. At the time of invention was made, it would have been obvious to one having

ordinary skill in the art to sell a padding apparatus system in conjunction with an associated backboard, since the examiner takes Official Notice of the equivalence of bed pads and foam mattress sold at medical supply store or company and pad of Holland's invention for their use in the backboard or medical art and the selection of any of these known equivalents to pads would be within the level of ordinary skill in the art.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tarla R. Patel whose telephone number is 571-272-3143. The examiner can normally be reached on M-F 6-3.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TP


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